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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,025	12/15/2003	Thomas E. Creamer	BOC9-2003-0069 (440)	4173
40/987 7590 06/06/2008 AKERMAN SENTERFITT P. O. BOX 3188 WEST PALM BEACH, FL 33402-3188				
EXAMINER				
GOODCHILD, WILLIAM J				
ART UNIT		PAPER NUMBER		
2145				
MAIL DATE		DELIVERY MODE		
06/06/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/736,025

Applicant(s)

CREAMER ET AL.

Examiner

WILLIAM J. GOODCHILD

Art Unit

2145

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-24 and 26-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-24 and 26-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: claims 24, 26-36 and 39 recite "machine readable storage", which is not defined within the specification. However, as an example, "machine readable storage" could be replaced with "a computer program product", which is defined within the specification, page 14, paragraph 46.

Claim Objections

2. Claims 11 and 34 are objected to because of the following informalities: claim 11 is dependent from claim 2 which is canceled and claim 34 is dependent from claim 25 which is canceled. Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15-23 and 38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 15 is directed to a "system" but fails to recite any hardware elements in the claim, which renders the claim solely as a software implementation and non-statutory for failing to satisfy a statutory category. In order for a claim to be statutory, it must fall within a process, machine, manufacture, or a composition of matter. Software does not fall within a statutory category since it is not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

Claims 16-23 and 38 are directed to a "system" but fail to recite any hardware elements in the claim, wherein the "means" instance of the claim are depicted as software per se, which renders the claim solely as a software implementation and non-statutory for failing to satisfy a statutory category. Additionally, the specification, page 14, paragraph 45 discloses "The present invention can be realized in hardware, **software**, or a combination of hardware and software.". In order for a claim to be statutory, it must fall within a process, machine, manufacture, or a composition of matter. Software does not fall within a statutory category since it is not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 37-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Lehikoinen et al., (US Publication No. 2005/0075097), (hereinafter Lehikoinen).

Regarding claims 37-39, Lehikoinen discloses establishing an instant messaging session [paragraph 25];
compiling and storing a transcript of the instant messaging session by an instant messaging client [paragraph 17];
detecting a scheduled event [paragraph 30];
publishing the transcript to a weblog responsive to detecting the scheduled event [paragraphs 30-31].

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3-4, 6-13, 15-18, 20-24, 26-27 and 29-36 are rejected under 35

U.S.C. 103(a) as being unpatentable over Lehtikainen, and further in view of Stone, Biz, (Blogging: Genius Strategies for Instant Web content), (hereinafter Stone).

Regarding claims 1, 15-16 and 24, Lehtikainen discloses establishing an instant messaging session [Lehtikainen, paragraph 25];

compiling a transcript of the instant messaging session by an instant messaging client [Lehtikainen, paragraph 17];

receiving a user request to publish the transcript of the session to at least one of a plurality of Weblogs [Lehtikainen, paragraphs 7 and 11];

determining a destination of the at least one Weblog [Lehtikainen, paragraph 18];

publishing the transcript to the at least one Weblog according to the indicator [Lehtikainen, paragraphs 17-18].

Lehtikainen does not specifically disclose generating an indicator indicating at least one of a format, font, and color in which the transcript is to be published. However, Stone, in the same field of endeavor discloses using a predefined template [Stone, chapter 16, 3rd paragraph under "Template Management Systems: The Future of Site Management", "WebCrimson goes beyond blogging in that you are allowed to create almost any type of site. Here is a list of WebCrimson's standard features:", "Automated templating technology for generating whole new areas of your site with a consistent look and feel including: Single Entry templates, Index templates, Blog templates"]. It would have

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been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the use of a predefined template in order to separate design from content.

Regarding claims 3, 17 and 26, Lehtikainen further discloses the step of saving the compiled transcript to a portion of memory that is local to the instant messaging client [Lehtikainen, paragraphs 7 and 17].

Regarding claims 4, 18 and 27, Lehtikainen further discloses detecting a state change in the portion of memory [Lehtikainen, paragraphs 30-31]; and responsive to said detecting step, sending the transcript to the weblog [Lehtikainen, paragraphs 30-31].

Regarding claims 6 and 29, Lehtikainen-Stone further discloses formatting the transcript according to a predefined template [Stone, chapter 16, 3rd paragraph under "Template Management Systems: The Future of Site Management"].

Regarding claims 7 and 30, Lehtikainen-Stone further discloses the predefined template specifies one of a plurality of weblogs to which the transcript is published, or one of a plurality of sections of the weblog to which the IM transcript is stored [Stone, chapter 16, 3rd paragraph, "WebCrimson goes beyond blogging in that you are allowed to create almost any type of site. Here is a list of WebCrimson's standard features:", "Automated

templating technology for generating whole new areas of your site with a consistent look and feel including: Single Entry templates, Index templates, Blog templates”].

Regarding claims 8 and 31, Lehtikoinen-Stone further discloses the template specifies instructions for processing the weblog according to an identity of a sender [Stone, chapter 18, 4th paragraph, “Posting via AIM™” and Figure 18.1].

Regarding claims 9, 20 and 32, Lehtikoinen further discloses exchanging electronic documents within the instant messaging session, wherein the electronic document is saved as part of the transcript [Lehtikoinen, paragraph 17].

Regarding claims 10 and 33, Lehtikoinen further discloses the electronic document specifies multimedia content [Lehtikoinen, paragraph 17].

Regarding claims 11, 21 and 34, Lehtikoinen further discloses joining a weblog agent to the instant messaging session, wherein the weblog agent records transactions of the instant messaging session [Lehtikoinen, paragraphs 17-18].

Regarding claims 12, 22 and 35, Lehtikoinen further discloses sending the transcript to the weblog using the weblog agent [Lehtikoinen, paragraphs 17-18].

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Regarding claims 13, 23 and 36, Lehtikainen-Stone further discloses formatting the transcript according to a template using the weblog agent [Stone, chapter 16, 3rd paragraph, "WebCrimson goes beyond blogging in that you are allowed to create almost any type of site. Here is a list of WebCrimson's standard features:", "Automated templating technology for generating whole new areas of your site with a consistent look and feel including: Single Entry templates, Index templates, Blog templates"].

8. Claims 5, 19 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lehtikainen-Stone as applied to claim 3, 17 and 26 above, and further in view of Linsey et al., (US Patent No. 6,791,582), (hereinafter Linsey).

Regarding claims 5, 19 and 28, Lehtikainen-Stone does not specifically disclose receiving a second user input requesting that the transcript be sent to the weblog; and sending the transcript to the weblog. However, Linsey discloses users may be allowed to copy the transcripts of a chat [Linsey, column 32, lines 25-31]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the users copying and sending the transcripts to a weblog in order to allow all users of the system to access a weblog.

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lehtikainen, and further in view of Roskind, (US Publication No. 2003/0065721).

Regarding claim 14, Lehtikoinen discloses one or more instant messaging clients configured to compile a transcript generated during an instant messaging session [Lehtikoinen, paragraph 17];
a weblog server configured to receive the transcript from the instant messaging client [Lehtikoinen, paragraph 18];
wherein within an instant messaging session, at least one of said instant messaging clients automatically publishes the transcript of the instant messaging session to the weblog server responsive to a user request or a scheduled event [Lehtikoinen, paragraphs 17 and 31].

Lehtikoinen does not specifically disclose an instant messaging server configured to establish an on-line interactive communication session between at least two or the instant messaging clients. However, Roskind discloses the sender accessing the host, the sender designates at least one recipient to receive an instant message [Roskind, paragraph 79]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a IM server in order to allow IM clients to interact with each other.

Response to Arguments

10. Applicant's arguments filed 04/07/2008 have been fully considered but they are not persuasive.

A – Applicant argues “It is noted that the system recited in claims 16-23 and 38 is not a software per se; rather it consists of different means or modules which can be implemented as hardware or a combination of hardware and software, and thus falls within the statutory category of a machine or product. It is also noted that an invention can be implemented in different ways. It is unreasonable to reject the claims just because it is stated in the specification that the invention can be realized as software. Nevertheless, in order to facilitate the prosecution, Claims 16-23 and 38 have been amended to specifically recite a ‘computer system.’”.

A - Claims 16-23 and 38 are directed to a “system” but fail to recite any hardware elements in the claim, wherein the “means” instance of the claim are depicted as software per se, which renders the claim solely as a software implementation and non-statutory for failing to satisfy a statutory category. Additionally, the specification, page 14, paragraph 45 discloses “The present invention can be realized in hardware, **software**, or a combination of hardware and software.”.

11. Applicant's arguments with respect to claims 1-39 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM J. GOODCHILD whose telephone number is (571)270-1589. The examiner can normally be reached on Monday - Friday / 8:00 AM - 4:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

WJG

/Jason D Cardone/
Supervisory Patent Examiner, Art Unit 2145